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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,973	02/26/2003	Douglas Barry	BARY 0001	9983
22862	7590	04/06/2006	EXAMINER	
GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025			NGUYEN, TRI V	
			ART UNIT	PAPER NUMBER
			1751	
DATE MAILED: 04/06/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,973

Applicant(s)

BARRY, DOUGLAS

Examiner

Tri V. Nguyen

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 19, 21-23, 41 and 43-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 20, 24-40 and 42 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/31/03 08/11/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-18, 20, 24-40 and 42, drawn to a method and an apparatus providing a game that support targeted advertisement, classified in class 705, subclass 14.
 - II. Claims 19 and 41, drawn to a method and an apparatus providing a game with segregation in categories of prizes, classified in class 463, subclass 1.
 - III. Claims 21 and 43, drawn to a method and an apparatus determining prizes targeted to contestant, classified in class 463, subclass 27.
 - IV. Claims 22-23 and 44-45, drawn to a method and an apparatus providing a selection of a prize depending on the cost, classified in class 463, subclass 25.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, III and IV are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group I discloses a method and an apparatus for providing a game integrated with targeted advertisement. The subcombination has separate utility such as Group II discloses a method and an apparatus for providing a game with prizes segregated in

Art Unit: 1751

categories; Group III discloses a method and an apparatus for determining the selection of prizes depending on the attributes of the contestant; and Group IV discloses a method and an apparatus for determining the selection of prizes based on cost factors.

3. During a telephone conversation with Michael Glenn on March 6 and 7, 2006 a provisional election was made without traverse to prosecute the invention of Group I, Claims 1-18, 20, 24-40 and 42. Affirmation of this election must be made by applicant in replying to this Office action. Claims 19, 21-23, 41 and 43-45 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

4. Claim 3 objected to because of the following informalities: Claim 3 recites "its presentation", it is unclear as to what "its" refer to. Appropriate correction is required.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown

Art Unit: 1751

to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-18 and 20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 and 20 of copending Application No. 10/147635. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications teach a method for providing a game with targeted advertisement and prize selection.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claims 24-40 and 42 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 24 – 40 and 42 of copending Application No. 10/147635. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1751

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 2 recites the limitation "said preference selections" in line 14. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1, 3, 4, 7, 9, 11, 12, 15, 24, 26, 27, 30, 32, 34, 35 and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Goldberg et al. (5,823,879).

Claim 1: Goldberg et al. discloses a method for presenting advertisements to a user comprising the steps of:

- a. receiving personal information about the user (col 4, lines 9-31; col 5, lines 4-24; col. 7, line to col 8, line 27; col 21 line 36 to col 22, line 48 and col 26, lines 21-23 and 41-45);
- b. providing a game for the user to play (col 4, lines 9-31; col 5, lines 4-24; col. 7, line to col 8, line 27; col 21 line 36 to col 22, line 48 and col 26, lines 21-23 and 41-45);
- c. selecting an advertisement from a pool of advertisements according to said personal information (col 4, lines 9-31; col 5, lines 4-24; col. 7, line to col 8, line 27; col 21 line 36 to col 22, line 48 and col 26, lines 21-23 and 41-45);
and

Art Unit: 1751

- d. integrating said advertisement into the game (col 4, lines 9-31; col 5, lines 4-24; col. 7, line to col 8, line 27; col 21 line 36 to col 22, line 48 and col 26, lines 21-23 and 41-45).

Claims 3 and 11: Goldberg et al. discloses the method of Claims 1 and 9 further comprising the steps of:

- a. allowing the user to activate an advertisement during the course of its presentation (col 26, lines 12-40 and col 28, lines 10-12);
- b. retrieving additional information for the activated advertisement (col 26, lines 12-40 and col 28, lines 10-12); and
- c. presenting said additional information to the user (col 26, lines 12-40 and col 28, lines 10-12).

Claims 4 and 12: Goldberg et al. discloses the method of Claims 3 and 11 wherein the additional information is in the form of a graphic image (col 26, lines 12-40).

Claims 7 and 15: Goldberg et al. discloses the method of Claim 3 wherein the additional information is in the form of an interactive multimedia presentation (col 26, lines 41-45).

Claims 9: Goldberg et al. discloses a method for presenting advertisements to a user comprising the steps:

- a. providing a game for the user to play (col 4, lines 9-31; col 5, lines 4-24; col. 7, line to col 8, line 27; col 21 line 36 to col 22, line 48 and col 26, lines 21-23 and 41-45);

Art Unit: 1751

- b. selecting an advertisement from a pool of advertisements according to a set of propensities describing the user (col 4, lines 9-31; col 5, lines 4-24; col. 7, line to col 8, line 27; col 21 line 36 to col 22, line 48 and col 26, lines 21-23 and 41-45); and
- c. integrating said advertisement into the game(col 4, lines 9-31; col 5, lines 4-24; col. 7, line to col 8, line 27; col 21 line 36 to col 22, line 48 and col 26, lines 21-23 and 41-45).

Claims 24, 26, 27, 30, 32, 34, 35 and 38 disclose the apparatus of the method claims 1, 3, 4, 7, 9, 11, 12 and 16 respectively. The prior art of Goldberg et al. as set forth in the method claims 1, 3, 4, 8, 9, 11, 12 and 15 are relied upon to reject Claims 24, 26, 27, 31, 32, 34, 35 and 39.

13. Claims 18, 20, 40 and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Kelly et al. (5,816,918).

Claim 18: Kelly et al. discloses a method for selecting prizes that a user can win in a game comprising the steps of:

- a. receiving a plurality of personal attributes describing a user (col 41, lines 44-65); and
- b. selecting a prize based on a subset of the said plurality of attributes (col 41, lines 44-65).

Claim 20: Kelly et al. discloses a method for selecting prizes that a user can win in a game comprising the steps of:

- a. presenting an enumeration of prizes that the user can win (col 25, lines 5-65 and Fig. 6c); and

Art Unit: 1751

- b. receiving from the user a selection of a prize presented in the enumeration (col 25, lines 5-65 and Fig. 6c).

Claims 40 and 42 disclose the apparatus of the method claims 18 and 20 respectively. The prior art of Goldberg et al. as set forth in the method claims 18 and 20 are relied upon to reject Claims 40 and 42.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 2, 5, 6, 8, 10, 13, 14, 16, 25, 28, 29, 31, 33, 36, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al. in view of Kelly et al.

Claims 2 and 10: Goldberg et al. discloses the method of Claims 1 and 9 but does not explicitly disclose further comprising the steps of:

- a. allowing the player to select preferences for prizes;
- b. monitoring the player's preference selections ; and
- c. updating said personal information to reflect said preference selections.

Goldberg et al. recites the features of gathering prize information for advertising purposes and updating the profile of users (col 15, lines 48-53 and col 23, lines 40-67). In an analogous art, Kelly et al. teaches that it is known to use prize selection in games to provide targeted advertising. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Goldberg et al., with the feature of prize

Art Unit: 1751

selection as taught by Kelly et al. One would have been motivated to modify the method with collecting information about the prize selection of the user to expand the profile information of the user thus increasing the efficiency of the targeted advertising.

Claims 5, 6, 8, 13, 14, 16: Goldberg et al. discloses the method of Claims 3 and 11 but does not explicitly disclose wherein the additional information is in the form of an animated graphic image, a video clip or an audio clip. In an analogous art, Kelly et al. teaches that it is known to use an animated graphic image, a video clip and an audio clip to present information to the user (col 23, lines 13-24). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Goldberg et al., with the feature of presenting the information in the form of an animated graphic image, a video clip and an audio clip as taught by Kelly et al. One would have been motivated to modify the method with the feature of presenting the information in the form of an animated graphic image, a video clip or an audio clip to diversify the formats of the information thus increasing the efficiency, attractiveness and pertinence of the information by using the most appropriate format to convey the information.

Claims 25, 28, 29, 31, 33, 36, 37 and 39 disclose the apparatus of the method claims 2, 5, 6, 8, 10, 13, 14 and 16 respectively. The prior art of Goldberg et al. as set forth in the method claims 2, 5, 6, 8, 10, 13, 14 and 16 are relied upon to reject Claims 25, 28, 29, 31, 33, 36, 37 and 39.

16. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al. in view of Goldberg et al.

Claim 17: Kelly et al. discloses a method for selecting prizes that a user can win in a game comprising the steps of:

a. allowing the user to play a game (col 41, lines 40-65);

Art Unit: 1751

- b. monitoring the users activity during game play to determine if the user is exhibiting a preference for a particular prize;
- c. presenting prizes that the user can win by playing said game wherein the prizes are selected based on a set of propensities exhibited by the user (col 41, lines 40-65); and
- d. updating said set of propensities to reflect said exhibited prize preference.

Kelly et al. does not explicitly disclose steps b and d. In an analogous art, Goldberg et al. teaches that it is known to monitor the user during the game play and to update the user profile with the user information (col 23, lines 40-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Kelly et al., with the feature monitoring the user actions and updating the user information as taught by Goldberg et al. One would have been motivated to modify the method with collecting information about the user during the game play to expand the profile information of the user thus increasing the efficiency of the targeted advertising.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Spaur et al. (6,196,920) discloses an on-line game playing with advertising.
- b. Small (5,791,991) discloses an interactive consumer product promotion method and match game.
- c. Stern (US 2003/0054884) discloses a method and apparatus for obtaining marketing information through the playing of a maze game.

Art Unit: 1751

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri V. Nguyen whose telephone number is (571) 272-6965. The examiner can normally be reached on M-F 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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